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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/028,748	12/21/2001	David H. Mack	018547-034810US	9678
33494	7590	05/10/2005	EXAMINER	
TOWNSEND AND TOWNSEND AND CREW LLP TWO EMBARCADERO CENTER 8TH FLOOR SAN FRANCISCO, CA 94111-3834			TUNG, JOYCE	
		ART UNIT		PAPER NUMBER
				1637

DATE MAILED: 05/10/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	10/028,748	MACK ET AL.
Examiner	Art Unit	
Joyce Tung	1637	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 2/14/05 AND 7/4/05.

2a) This action is FINAL.                    2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 1-10,12-19,25-34,36-43 and 49-64 is/are pending in the application.

4a) Of the above claim(s) 54 and 55 is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 1-10,12-19,25-34,36-43,49-53 and 56-64 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All    b) Some \* c) None of:

1. Certified copies of the priority documents have been received.

2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.

3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) Notice of References Cited (PTO-892)

2) Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.

4) Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.

5) Notice of Informal Patent Application (PTO-152)

6) Other: \_\_\_\_\_.

### **DETAILED ACTION**

1. The applicant's response filed 2/13/05 and 7/8/04 to the Office action has been entered. Claims 1-10, 12-19, 25-34, 36-43, 49-55 and 56-64 are pending. Claims 54-55 are withdrawn from further consideration as non-elected group.
2. Claims 1-10, 12-19, 25-34, 36-43 and 49-53 remain rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-50 of U.S. Patent No. 6,420,108 because the terminal disclaimer has not been filed.
3. Claims 1-10, 12-19, 25-34, 36-43 and 49-53 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Lockhart et al. (WO97/27317, 21 July 1997 in view of Zhao et al. (Gene, 1995, Vol. 156, pg. 207-213).

The teachings of Lockhart et al. and Zhao et al. are set forth in the Office action mailed 4/05/2004.

The response filed 2/14/2005 argues that Zhao et al. alone or in combination with Lockhart et al. (WO 97/27317) do not disclose "receiving an input of selection of said first mark" and "in response to said input, displaying information associated with said first expressed sequence". However, Zhao et al. teach that 408 and 288 clones were found to be preferentially expressed in the adult and fetal brain respectively (See pg. 207, the abstraction). The teachings of Zhao et al. are interpreted as the limitations that "receiving an input of selection of said first mark" and "in response to said input, displaying information associated with said first expressed sequence".

The response filed 7/18/04 further argues that Zhao et al did not know information obtained from a sequencing analysis. However, Zhao et al. teach that the high-density cDNA

filter analysis (HDCFA) system includes sequencing analysis of clones of interests (See pg. 209, fig. 1). Thus, it would have been *prima facie* obvious to apply the system of Zhao et al. for analyzing expression level information. Thus the rejection is maintained.

Claims 56-64 are also rejected under 35 U.S.C. 103(a) as being unpatentable over Lockhart et al. (WO97/27317, 21 July 1997) in view of Zhao et al. (Gene, 1995, Vol. 156, pg. 207-213).

As the teachings of Lockhart et al. and Zhao et al. set forth in the Office action mailed 4/05/2004, the teaching of Lockhart et al. and Zhao et al. read on the limitations of the claims. Thus, the rejection is made with the same seasons as set forth in the Office action mailed 4/05/2004.

## **NEW GROUND OF REJECTION**

### *Claim Rejections - 35 USC § 112*

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claims 1-10, 12-19, 25-34, 36-43 and 49-53 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Since the newly added limitation "obtained from a sequencing analysis" in claims 1, 25 and 49-50 was not found in the specification, it constitutes new matter.

6. Newly submitted claims 56-64 are also rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Since the newly added limitation “said information is free from said first expression level and said second expression level” in claim newly added claim 56 has no support in the specification, it constitutes new matter.

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

8. Claims 56-64 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

a. Claims 56-64 are vague and indefinite because it is unclear what is encompassed in the limitation “said information is free from said first expression level and said second expression level” as in terms of the limitation “said information comprises a description for said first expressed sequence”. Clarification is required.

### Summary

9. No claims are allowed.

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a).  
Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

11. Any inquiries concerning this communication or earlier communications from the examiner should be directed to Joyce Tung whose telephone number is (571) 272-0790. The examiner can normally be reached on Monday-Friday from 8:00 AM-4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Benzion can be reached at (571) 272-0782 on Monday-Friday from 10:00 AM-6:00 PM.

12. Papers related to this application may be submitted to Group 1600 by facsimile transmission. Papers should be faxed to Art Unit 1637 via the PTO Fax Center located in Crystal Mall 1 using 571 273-8300. The faxing of such papers must conform with the notice published in the Official Gazette, 1096 OG 30 (November 15, 1989).

Joyce Tung

April 22, 2005

*Kenneth R. Horlick*  
KENNETH R. HORLICK, PH.D  
PRIMARY EXAMINER  
*5/3/05*